

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 46320
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Frank LEYMANN, et al. : Confirmation Number: 5078
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Application No.: 10/042,799 : Group Art Unit: 2157
: :
Filed: January 9, 2002 : Examiner: A. Gold
: :
For: MANAGING A FAILURE TO ACCESS A DATABASE IN A COMPUTER SYSTEM

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Sir:

Applicants request that a Panel Review of the final rejection in the Third Office Action dated February 13, 2006, be performed in the above identified application.

CLAIMS 1-14 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HOLMBERG ET AL., U.S. PATENT NO. 6,247,141 (HEREINAFTER HOLMBERG), IN VIEW OF RIZVI ET AL., U.S. PATENT NO. 6,490,610 (HEREINAFTER RIZVI)

In the second Office Action dated August 12, 2005, the Examiner rejected claims 1-10 under 35 U.S.C. § 103 for obviousness based upon Holmberg in view of Rizvi. In the Amendment filed November 4, 2005, Applicants amended independent claims 1 and 7 to clarify the distinctions between the claimed invention and the combination of Holmberg and Rizvi. Additionally, Applicants presented arguments on pages 6-8 of the Amendment, which conclude that

"even if Holmberg were modified in view of Rizvi, the claimed invention would not result" (emphasis in original). Applicants also added claims 11-14.

In the present third and Final Office Action dated February 13, 2006, the Examiner again rejected claims 1-10 (and additionally claims 11-14) under 35 U.S.C. § 103 for obviousness based upon Holmberg in view of Rizvi. Upon reviewing the Examiner's statement of the rejection, however, Applicants note several serious deficiencies.

Applicants have compared the Examiner's statement of the rejection for independent claims 1 and 7 in the second Office Action (i.e., the paragraph spanning pages 2 and 3 and the first 3 full paragraphs on page 3) with the statement of the rejection for independent claims 1, 7, and 11 in the third Office Action (i.e., the paragraph spanning pages 2 and 3 and the first 3 full paragraphs on page 3). The result of this comparison is that besides the third Office Action referring to newly added claim 11, the only difference between these statements of rejection is that the third Office Action includes the phrase "while the first one of the two application servers (20, 21) fails to access the database." This phrase is identical to a phrase added to claim 1 in the Amendment.

Therefore, despite the Applicants' arguments on pages 6-8 of the Amendment that Holmberg and Rizvi, either alone or in combination, fail to teach the limitation "while the first one of the two application servers (20, 21) fails to access the database," the Examiner has responded to these extensive arguments by simply asserting that that this limitation is disclosed by Holmberg without any comment or analysis. Although the Examiner cites column 3, lines 5-22 of Holmberg for support, this passage is completely silent as to this claimed limitation.

On page 5 of the third Office Action in the section entitled "*Response to Arguments*" the Examiner stated the following:

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Applicants note, however, that the Examiner has not issued new grounds for a rejection since the Examiner previously rejected the claims under 35 U.S.C. § 103 for obviousness based upon Holmberg in view of Rizvi and is now currently rejecting the claims under 35 U.S.C. § 103 for obviousness based upon Holmberg in view of Rizvi. In this regard, reference is made to M.P.E.P. § 707.07(f), which states that "the Examiner, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Moreover, M.P.E.P. § 707.07(f) also states that even if the arguments are moot in view of the new ground(s) of rejection, the "examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied" (emphasis added). Since Applicants' arguments with regard to Holmberg and Rizvi are still relevant, the Examiner has failed to meet the requirements of M.P.E.P. § 707.07(f).

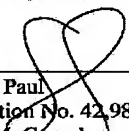
Applicants further note that although independent claims 7 and 11 contain similar limitations to those limitations recited in independent claim 1, independent claims 7 and 11 are not identical to independent claim 1. However, the Examiner has not recognized these differences in the statement of the rejection since the Examiner's comments in the statement of the rejection only refer to the limitations recited in claim 1. Thus, the Examiner has failed to establish a prima facie case of obviousness in rejecting claims 7 and 11.

Therefore, for all the reasons stated above, Applicants submit that the rejections of record are clearly not proper and are without basis. Thus, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-14 under 35 U.S.C. § 103 based upon Holmberg in view of Rizvi.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 15, 2006

Respectfully submitted,



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